

REMARKS

Claims 1-40 are all of the pending claims. Dependent method claims 33 and 34 remain withdrawn from consideration.

Interview

As an initial matter, Applicant thanks the Examiner for the courtesies extended to Applicant and Applicant's representative during the personal interview on November 18, 2004, during which the rejection of independent claim 1 was discussed. Applicant has addressed the positions asserted by the Examiner during the interview in the remarks below.

Allowable Subject Matter

Claims 3, 6, 9, 12-30, and 35-40 are allowed.

Claim Rejections Under 35 U.S.C. § 103

Claims 1, 2, 4, 5, 7, 8, 10, 11, and 31 are rejected under 35 U.S.C. § 103(a) as being as being allegedly unpatentable over Darby (US 5,491,909) ("Darby '909") in view of Darby et al. (US 5,370,133) ("Darby '133"), and further in view of Grim et al. (US 5,329,705). Claims 32 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Darby '909 in view of Darby '133 and Grim, and further in view of Kellerman et al. (US 5,799,414).

Claim 1

As an initial matter, claim 1 has been amended in order to clarify the scope of subject matter claimed.

Applicant respectfully requests that the Examiner withdraw the rejection of amended, independent claim 1 at least because there is no combination of Darby '909, Darby '133, and

Grim that would reasonably teach or suggest all of the claim's recitations. For example, there is no combination of Darby '909, Darby '133, and Grimm that would reasonably teach or suggest the claimed medical shoe in which "the out sole circumferential counter prevents each of the plurality of insole layers from shifting within the out sole cavity when the insole layers are stacked in each of the different orders."

In the *non-limiting* embodiment shown in Fig. 3 of the original specification, a circumferential counter 120 prevents shifting of the layers 600, 620, 640, and 660. As shown in Figs. 8-13, these layers 600, 620, 640, and 660 can be rearranged in different orders. The circumferential counter 120 prevents shifting of the layers 600, 620, 640, and 660 even when they are arranged in an order different than that shown in Fig. 3.

As an initial matter, during the interview, the Examiner acknowledged that the individual removable areas 68 of Grim's upper resilient area 66 (*See Grimm at Fig. 2*) cannot correspond by themselves to one of the recited plurality of separably removable insole layers. If the removable areas 68 were removed from the inner sole assembly 52, the circumferential counter would not "prevent the [removable areas] from shifting within the out sole cavity when the insole layers are stacked in each of the different orders." The Examiner, however, asserted that Grimm's soft goods support member 20 and inner sole assembly 52 can be considered the recited plurality of separably removable insole layers. *See Grimm at Fig. 2.*

However, Applicant respectfully submits that the layers 20 and 52 of Grimm cannot be considered as corresponding to the recited "plurality of separably removable insole layers" because the out sole circumferential counter prevents each of the plurality of insole layers from

shifting within the out sole cavity when the insole layers are stacked in each of the different orders.

Even assuming *arguendo* that a circumferential counter would prevent the layers 20 and 52 of Grimm from shifting when the inner sole assembly 52 is stacked on top of the soft goods support member 20, as shown in Fig. 3, there is no teaching or suggestion that the circumferential counter would prevent the layers 20 and 52 of Grimm from shifting within the out sole cavity if the soft goods support member 20 is stacked on top of the inner sole assembly 52. This is because the soft goods support member 20 and inner sole assembly 52 are designed so that when the inner sole assembly 52 is provided on top of the soft goods support member 20, the side flaps 48 of the soft goods support member 20 hold the inner sole assembly 52 in place within the frame 14. However, if the order of the soft goods support member 20 and inner sole assembly 52 were reversed and the inner sole assembly were placed on the bottom of the soft good support member 20, then the inner sole assembly 52 would not be held in place by the side flaps 48 of the soft goods support member 20 within frame 14. Instead, the inner sole assembly 52 would be loosely placed within the frame 14 and would not be prevented from shifting.

In view of the discussion above, Applicant respectfully requests that the Examiner withdraw the rejection of claim 1.

Claim 31

Claim 31 has also been amended in order to clarify the scope of subject matter claimed. Applicant respectfully requests that the Examiner withdraw the rejection of amended, independent claim 31 at least because there is no combination of Darby '909, Darby '133, and

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Grim that would reasonably teach or suggest all of the claim's recitations. For example, there is no combination of Darby '909, Darby '133, and Grimm hat would reasonably teach or suggest the claimed medical shoe in which "the out sole circumferential counter prevents each of the plurality of insole layers from shifting within the out sole cavity when the insole layers are stacked in each of the different orders", as discussed above with respect to claim 1.

Claims 2, 4, 5, 7, 8, 10, 11, and 32

In addition, Applicant respectfully requests that the Examiner withdraw the rejection of dependent claims 2, 4, 5, 7, 8, 10, and 11 at least because of their dependency from claim 1.

Applicant respectfully requests that the Examiner withdraw the rejection of dependent claim 32 at least because of their dependency from claim 3, and because Kellerman does not make up for the deficiencies in the combination of Darby '909, Darby '133, and Grimm discussed above.

New Claims

In addition, Applicant has added new dependent claims 41 and 42 that depend from claims 1 and 31, respectively. These new claims recite that the plurality of separably removable insole layers include at least three layers.

Applicant respectfully submits that these claims are allowable at least because of their dependency from one of claims 1 and 31 and because Applicant sees no teaching or suggestion in Grim, or any of the applied references for that matter, to provided three separably removable insole layers instead of the two layers 20, 52 of Grimm alleged by the Examiner.

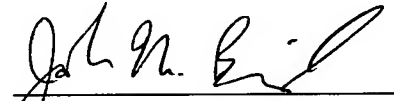
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Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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